

REMARKS

This Amendment is submitted in response to the Office Action dated January 15, 2004. In the Office Action, the Patent Office rejected Claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Jones* (U.S. Patent No. 5,882,667) in view of *Martin et al.* (U.S. Patent No. 1,134,691).

By the present Amendment, Applicant amended Claims 15 and 17 and added Claim 21. Applicant submits that the amendments to the claims overcome the rejection and objection thereto as made by the Patent Office and places the application in condition for allowance.

Applicant notes with appreciation that the Patent Office indicated that Claims 9 and 11-14 are in allowable form, and further indicated that Claim 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicant added Claim 21, incorporating the limitations from Claim 17 into Claim 19. Applicant, therefore, submits that Claim 21 is also in allowable form. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over *Jones* (U.S. Patent No. 5,882,667) in view of *Martin et al.* (U.S. Patent No. 1,134,691). Applicant submits that this rejection is improper for the reasons that follow.

Independent Claims 15 and 17, as amended, require a marking device having a barrel having an exterior surface wherein a means for producing a mark is within the barrel. Further, Claims 15-17 require a sheath that fits around and/or partially covers the

exterior surface of the barrel.

Neither *Jones* nor *Martin et al.*, taken either singly or in combination, teach a sheath which fits around and/or covers an exterior surface of a barrel which contains a means for producing a mark. The Patent Office alleges that *Jones* teaches a sheath. However, the sheath which the Patent Office refers to merely serves as a barrel for containing a means for producing a mark. No sheath is provided in *Jones* for fitting around and/or covering an exterior surface of the barrel, as required by amended Claims 15 and 17. Therefore, *Jones* teaches only a barrel and does not include a sheath in addition to the barrel, as required by Claims 15 and 17. Because Claims 15 and 17 require an additional element, namely, a sheath, Applicant asserts that Claims 15 and 17 do not read on the structure of *Jones*.

Martin et al. merely teach a pencil having a clasp which is suspended from a flexible stem.

Neither *Jones* nor *Martin et al.*, taken either singly or in combination, teach a sheath which fits around and/or covers an exterior surface of a barrel of a marking device. Therefore, Applicant asserts that one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to combine *Jones* with *Martin et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in

the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's method for using a marking device. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). Moreover, Applicant submits that absolutely no teaching, suggestion and/or incentive exists to combine *Jones* with *Martin et al.* in the manner suggested by the Patent Office. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

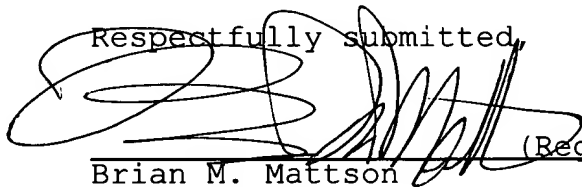
Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the resultant combination still lacks the novel structural elements and steps positively recited in Claims 15 and 17, respectively. Namely, neither *Jones* nor *Martin et al.*, taken singly or in combination, teach or suggest a marking device having a sheath that partially covers a barrel containing a means for producing a mark. Accordingly, the rejection of Claims 15-17 by the Patent Office under 35 U.S.C. §103(a) is improper and should be withdrawn. Notice to that effect is requested.

Claim 16 depends from Claim 15, and Claim 19 depends from

Claim 17. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's marking device accessory kit and method for using a marking device, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

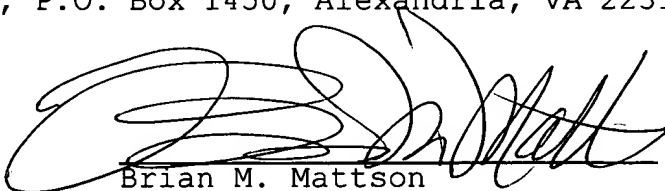


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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** and **Check for \$43.00** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 14, 2004.



Brian M. Mattson